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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/652,989	08/29/2003	Cary E. Gloodt	12810-43112	1942
35973	7590	04/06/2005	EXAMINER	
BINGHAM MCHALE LLP 2700 MARKET TOWER 10 WEST MARKET STREET INDIANAPOLIS, IN 46204-4900			CARIASO, ALAN B	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/652,989	Applicant(s) GLOODT ET AL.	
	Examiner Alan Cariaso	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8-16, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 4, 7, 17, 18 and 21-25 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20030829</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "28A" designated a non-rotating portion being a brake caliper on page 11, lines 21-22. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: Page 1, line 4, the recited related patent application 10/071,360 should be updated to include its current issued US Patent --6,612,726--.

Appropriate correction is required.

Claim Objections

3. Claims 4 and 17 are objected to because of the following informalities:
4. Claim 4, line 7, the last term used in "at least two connecting member" should be made plural by adding an -s.
5. Claim 17, line 2, there are two articles "the a" addressing "brake shield". Since there would be no antecedent basis for "brake shield" if addressed with "the", then "the" should be deleted.
6. Claim 17, line 3, the word "stabalizingly" is misspelled.
7. Appropriate correction is required.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1, 2, 13, 15 and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over at least claims 19 and 20 of U.S. Patent No. 6,612,726. Although the conflicting claims are not identical, they

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are not patentably distinct from each other because claim 19 of GLOODT patent '726 claims a bracket secured to an automobile wheel brake caliper, a light emitting diode array connected to the bracket, and power source electrically connected to the light emitting diode array, which is an obvious arrangement of the present claim 1 of a bracket assembly mounted to a brake caliper of an automobile; a lighting assembly mounted to the bracket assembly, and an electrical power source electrically connected to the light assembly. A bracket and light emitting diode array are obviously similar to the claimed bracket assembly and light assembly, because any part or element that is formed in any manner are well known to form an assembly. As for the claimed "nondestructively connected" in claims 13 and 15, not claimed by patent '726, it is well known that any mechanical connection is obviously nondestructive for the purpose of having undamaged parts remain with good integrity or in acceptable working condition, that even any openings for fasteners in any of the connecting members are known to be at least formed with the original connecting member, and therefore is not considered be destructive when parts have pre-determined connectable means, in order to facilitate connection of parts.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1, 3, 5, 6, 8, 9, 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by MALDONADO (US 5,964,312).

12. MALDONADO discloses a bracket assembly (12,112b4 in fig.7) mounted to a brake caliper (130 in fig.8) being a non-rotating portion of an automobile wheel (16); a lighting assembly (114b,114b2 in fig.7 col.5, lines 58-67) mounted to the bracket assembly (12,112b,112b4 in fig.7); and an inherent electrical power source electrically connected to the lighting assembly (114b,114b2); wherein the bracket assembly (12,112b,112b4) further comprises at least one elongated member (11,figs.7-8) extending from the lighting assembly (114b,114b2) to the brake caliper (130); and at least one fastener (131) connecting that at least one elongated member (11) to the brake caliper (130); wherein the bracket assembly (12,112b,112b4) is bolted (131) to the brake caliper (130); wherein the bracket assembly (12,112b,112b4) being clamped (by means of fastener 131-fig.8) to the brake caliper (130); a bracket assembly (12,112b) mounted to an automobile axel (161) being a non-rotating portion of an automobile wheel (16); a lighting assembly (114b,114b2) mounted to the bracket assembly (12,112b); and an inherent electrical power source electrically connected to the lighting assembly (114b,114b2); the bracket assembly further comprises an axel-encircling member (plate 164) mounted to the axel (161); and at least one elongated

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member (externally threaded member with nut 163) extending between the axel-encircling member (164) and the lighting assembly (114b,114b2).

13. Claims 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by LIPSKI (US 3,493,739).

14. LIPSKI discloses a bracket assembly (42,43) mounted to a wheel strut (14); a lighting assembly (36) mounted to the bracket assembly (42,43) and an electrical power source (col.2, lines 45-46) electrically connected to the lighting assembly (36); wherein the wheel strut (14) is interpreted as an upper control arm (with respect to the seat 12); the bracket assembly (42,43) further comprising a clamp (43) mounted to the wheel strut and an elongated connecting member (42) extending between the clamp (43) and the lighting assembly (36).

15. Claims 15, 16 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by LEE (US 6,322,237).

16. LEE discloses a bracket (40) nondestructively secured (col.6, lines 50-60) to a non-rotating portion (17,28) of an automobile wheel (12); a light emitting array (22,24,16) connected to the bracket (40); a power source (54) electrically connected to the light emitting array (22,24,16); wherein the light emitting array (22,24,16) is positioned to intermittently shine light through the at least partially transparent wheel covering (col.5, lines 7-25); wherein the bracket (40) is adjustably positionable relative the non-rotating portion (17,28) of the automobile wheel (col.6, lines 46-57); wherein the

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non-rotating portion (17,28) of the automobile wheel (12) is at least automobile axel (28); further an electronic controller (col.5, lines 30-34) operationally connected to the light emitting array and is operable to sequence the actuation of the light emitting array (24,16).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over MALDONADO (US 5,964,312) in view of MALDONADO (US 5,992,587).

19. MALDONADO '312 discloses the claimed invention except the electrical power source being an automobile battery.

20. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the illumination wheel assembly of MALDONADO '312 to include electrical connection to an automobile battery since it is well known in the art of vehicle illumination devices to connect the proximal illumination devices mounted on the vehicle to the most available proximal power source being the automobile battery in order to conveniently provide power to the illumination devices while avoid further accommodation of extra separate power sources while the vehicle is mobile.

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21. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over LEE (US 6,322,237) in view of BRADWAY (US 3,113,727).

22. LEE discloses the claimed invention including the electronic controller (col.5, lines 30-34) adapted to receive a control signal, and with at least flashing, blinking or flickering signify the light sources or array being changed between first and second light emitting states. However, LEE does not disclose a relay that actuates change between lighting states. BRADWAY teaches an armature of a relay (col.3, lines 65-69) for the purpose controlling the flasher for determining energization and deenergization of the armature and therefore that of the light sources (64,65).

23. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the illumination wheel assembly of LEE to include type of relay as taught by BRADWAY in order to control activation of the flasher and therefore control the flashing time of the light sources on the wheel device.

Allowable Subject Matter

24. Claims 4, 7, 17, 18 and 21-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and any corrected of any minor informalities.

25. The following is a statement of reasons for the indication of allowable subject matter: A lighting assembly mounted to a bracket assembly mounted to a brake caliper of an automobile wheel, the bracket assembly further comprising a plurality of elongated

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members pivotally connected to each other to form a generally rectangular framework, at least two connecting members between the rectangular framework and the brake caliper and at least two fasteners connecting the at least two connecting members to the brake caliper (claim 4); a lighting assembly mounted to a bracket assembly mounted to a brake caliper of an automobile wheel, the lighting assembly further comprising a circular frame and plurality of light emitting diodes positioned within the frame (claim 7); a stabilizing member extending to the brake shield and pivotally connected to the bracket and wherein the stabilizing member is stabilizingly connected to the brake shield (claims 17 and 18); the light emitting array includes at least a plurality of tricolor diodes (claims 21-25).

Conclusion

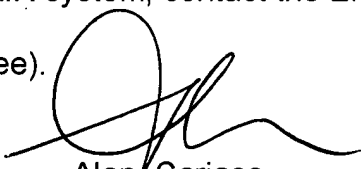
26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. SPICER (US 6,176,603) shows adjustable bracket or support (fig.5) surrounding or clamping a stationary portion being an axle (37) of an automobile, the bracket supporting lighting assemblies (18,19, fig.3). HINRICHS (US 4,381,537) shows a non-rotating light shield with array of light sources (figs.3-4) supported by the axle plate about an axle. CASTRO (US 2003/0198059) shows a plurality of light sources (3,3') supported by elongate members (4,4') and a mounting device (5) on a wheel strut (32).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Cariaso whose telephone number is (571) 272-2366. The examiner can normally be reached on 9-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alan Cariaso
Primary Examiner
Art Unit 2875

April 4, 2005
AC